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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,290	08/18/2003	Colin Charles Owen Goble	978-72	2016
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NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
			EXAMINER WILLIAMS, KENNETH C	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,290

Applicant(s)

GOBLE, COLIN CHARLES OWEN

Examiner

Kenneth C. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 11, 14 and 17 is/are rejected.
7) ☒ Claim(s) 12, 13, 15 and 16 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/9/2003.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 6-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/21/05.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the RF output stage must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

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is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because element 124, a scissors-type handle assembly, on page 7, line 10 is not shown in the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a) because they fail to show how element 69, a capacitor, is connected between elements 62A and 62B, output connections as described in the specification on page 5, lines 20-21. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities:
- a. On page 1, line 9, "generators which provide", should be changed to --generators with--.
 - b. On page 5, line 25, "range of from", should be changed to --range from--.
 - c. On page 6, line 9, "range of from", should be changed to --range from--.
- Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The function of the RF output stage is not clearly stated in the disclosure.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klett et al. (German Patent Application No. 4339049) in view of Wrublewski et al. (U.S. Patent No. 6174309).

a. In regards to Claim 1, discloses a electrosurgical system comprising "a generator for generating RF power" (See Klett et al. page 8, line 20 – page 9, line 6), "and electrosurgical instrument including at least two electrodes" (See Klett et al. page 8, line 20 – page 9, line 6), "an identification element carried by the instrument and being representative of at least the number of electrodes present on the instrument" (See Klett et al. page 9, lines 13-19), "an RF output stage having at least pair of RF output lines" (See Klett et al. page 9, line 22 – page 10, line 3), "a power supply coupled to the output stage for supplying power to the output stage" (See Klett et al. page 8, line 20 – page 9, line 6), "a controller capable of varying an RF signal supplied to the RF output lines" (See Klett et al. page 8, line 20 – page 9, line 6) and "a sensing circuit adapted to sense the identification element carried by the instrument" (See Klett et al. page 5, line 10 – page 6, line 4).

Klett et al. does not disclose "a switching circuit having at least three output connections, each of at least two of which being in electrical connection with a respective one of the at least two electrodes". Attention is directed to the Wrublewski et al. reference which in an analogous field of endeavor teaches the use of a switching device to provide power to selected electrodes (See Wrublewski column 5, line 61 – column 6, line 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system of Klett et al. with the switching device as taught by Wrublewski et al. because having multiple electrodes to cut and coagulate tissue would require a mechanism to select the electrodes for the required function.

b. In regards to Claim 2, Klett et al. in view of Wrublewski et al. discloses an electrosurgical system (See Claim 1 Rejection). Klett et al. further discloses "the identification element is a resistor" (See Klett et al. page 6, lines 5-9) and "the sensing circuit is adapted to sense the resistance of the identification element" (See Klett et al. page 5, line 10 – page 6, line 12). The examiner notes that Klett et al. does not explicitly say the sensing circuit is adapted to sense the resistance of the identification element, but it is understood that the sensing circuit must be inherently configured to sense the resistance in view of the teaching of Klett et al. that the identification element can be a resistor.

c. In regards to Claim 3, Klett et al. in view of Wrublewski et al. discloses an electrosurgical system (See Claim 1 Rejection). Klett et al. further discloses "the identification element is a capacitor, and the sensing circuit is adapted to sense

the capacitance of the identification element” (See Klett et al. page 5, line 10 – page 6, line 12). The examiner notes that Klett et al. does not explicitly say the sensing circuit is adapted to sense the capacitance of the identification element, but it is understood that the sensing circuit must be inherently configured to sense the capacitance in view of the teaching of Klett et al. that the identification element can be capacitive.

d. In regards to Claim 4, Klett et al. in view of Wrublewski et al. discloses an electrosurgical system (See Claim 3 Rejection). Klett et al. further discloses, “the sensing circuit includes an inductor such as to form a resonant circuit with the identification element, the sensing circuit being adapted to determine the resonant frequency of the resonant circuit so as to identify the identification element” (See Klett et al. page 6, line 16 – page 7, line 5). The examiner notes that Klett et al. does not explicitly say the sensing circuit is adapted to sense the inductance of the identification element, but it is understood that the sensing circuit must be inherently configured to sense the inductance in view of the teaching of Klett et al. that the identification element can be inductive.

e. In regards to Claim 5, Klett et al. in view of Wrublewski et al. discloses an electrosurgical system (See Claim 1 Rejection). Klett et al. further discloses “the controller is such as to adjust automatically the RF power supplied to at least one of the three or more output connections to limit the peak generator output voltage to at least a first value when a first combination of electrodes is selected by the switching circuit, and to at least a second value when a second combination of

electrodes is selected by the switching circuit" (See Klett et al. page 8, line 20 – page 9, line 6).

f. In regards to Claim 17, Klett et al. discloses an apparatus comprising "a generator for generating RF power" (See Klett et al. page 8, line 20 – page 9, line 6), "a plurality of electrosurgical instruments, the plurality of electrosurgical instruments including at least one electrosurgical instrument having two electrodes, and at least one electrosurgical instrument having at least three electrodes" (See Klett et al. Figure 5 and 6; see also page 10, line 20 – page 11, line 21), "each of the plurality of electrosurgical instruments having an identification element carried by the instrument and being representative of at least the number of electrodes present on the instrument" (See Klett et al. page 9, lines 13-19), "an RF output stage having at least pair of RF output lines" (See Klett et al. page 9, line 22 – page 10, line 3), "a power supply coupled to the output stage for supplying power to the output stage" (See Klett et al. page 8, line 20 – page 9, line 6), "a controller capable of varying an RF signal supplied to the RF output lines" (See Klett et al. page 8, line 20 – page 9, line 6), and "a sensing circuit adapted to sense the identification element carried by the instrument" (See Klett et al. page 5, line 10 – page 6, line 4).

Klett et al. does not disclose "a switching circuit having at least three output connections, each of at least two of which being in electrical connection with a respective one of the at least two electrodes". Attention is directed to the Wrublewski et al. reference which in an analogous field of endeavor teaches the

use of a switching device to provide power to selected electrodes (See Wrublewski column 5, line 61 – column 6, line 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system of Klett et al. with the switching device as taught by Wrublewski et al. because having multiple electrodes to cut and coagulate tissue would require a mechanism to select the electrodes for the required function.

12. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klett et al. (German Patent Application No. 4339049) in view of Wrublewski et al. (U.S. Patent No. 6174309) as applied to claim 1 above, and further in view of Roos (U.S. Patent No. 5269780).

a. In regards to Claim 11, Klett et al. in view of Wrublewski et al. disclose an apparatus (See Claim 1 Rejection).

Klett et al. in view of Wrublewski et al. does not disclose, “at least one of the electrodes is in the form of a hook”. Attention is directed to the Roos reference, which in an analogous field of endeavor discloses an electrosurgical apparatus utilizing electrodes in the form of needles or hooks (See Roos Figure 2; see also column 1, lines 21-33 and column 3, line 64 – column 4, line 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Klett et al. in view of Wrublewski et al. with the hook structure of Roos to provide a cutting and coagulating electrosurgical device for laparoscopic surgery.

- b. In regards to Claim 14, Klett et al. in view of Wrublewski et al. disclose an apparatus (See Claim 1 Rejection).

Klett et al. in view of Wrublewski et al. does not disclose, "at least three of the electrodes are each in the form of a hook". Attention is directed to the Roos reference, which in an analogous field of endeavor discloses an electrosurgical apparatus utilizing three electrodes to cut and coagulate tissue (See Roos Figures 3 and 4; see also column 4, lines 54-60 and column 5, lines 25-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Klett et al. in view of Wrublewski et al. with the hook structure of Roos to provide a cutting and coagulating electrosurgical device for laparoscopic surgery.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1 and 11-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 and 11-16 of

Goble et al. (U.S. Patent No. 6929641) in view of Klett et al. (German Patent Application No. 4339049). For double patenting to exist as between the rejected claims and patent Claims 1-4 and 11-16, it must be determined that the rejected claims are not patentably distinct from Claims 1-4 and 11-16. In order to make this determination, it first must be determined whether there are any differences between the rejected claims and Claims 1-4 and 11-16 and if so, whether those differences render the claims patentably distinct.

Claim 1 recites an "a generator for generating RF power" (See lines 1-2 of Claim 1 of the patent), "an electrosurgical instrument including at least two electrodes" (See lines 2-3 of Claim 1 of the patent), "an RF output stage having at least a pair of RF output lines" (See lines 2-3 of Claim 2 of the patent), "a power supply coupled to the output stage for supplying power to the output stage, "a controller capable of varying an RF signal supplied to the RF output lines" (See lines 4-5 of Claim 2 of the patent), and "a switching circuit having at least three output connections, each of at least two of which being in electrical connection with a respective one of the at least two electrodes" (See lines 6-16 of Claim 2 of the patent).

The difference between Claim 1 of the application and Claims 1 of the patent lies in the fact that the application claim includes "a sensing circuit adapted to sense the identification element carried by the instrument, the arrangement being such that the switching circuit operates to connect the RF output lines to two or more of the at least three output connections depending on the identification element carried by the instrument". Attention is directed to the Klett et al. reference, which discloses an electrosurgical system with coding and decoding devices (See Klett et al. page 5, line

10 – page 6, line 4 and page 9, lines 13-19). It would have been obvious to modify the device of Goble et al. with the teaching of Klett et al. to optimize the electrosurgical signal depending on the instrument connected to the generator.

Claim 11 recites, “at least one of the electrodes is in the form of a hook” (See lines 1-2 of Claim 11). It is clear that all the elements of Claim 11 of the application are to be found in Claim 11 of the patent. Since Claim 11 is anticipated by Claim 11 of the patent, it is not patentably distinct from Claim 11 of the application.

Claim 12 recites, “at least one hook electrode extends distally beyond the other electrodes” (See lines 1-2 of Claim 12). It is clear that all the elements of Claim 12 of the application are to be found in Claim 12 of the patent. Since Claim 12 is anticipated by Claim 12 of the patent, it is not patentably distinct from Claim 12 of the application.

Claim 13 recites, “there is a centrally-positioned electrode extending distally beyond the other electrodes” (See lines 1-3 of Claim 13). It is clear that all the elements of Claim 13 of the application are to be found in Claim 13 of the patent. Since Claim 13 is anticipated by Claim 13 of the patent, it is not patentably distinct from Claim 13 of the application.

Claim 14 recites, “at least three of the electrodes are each in the form of a hook” (See lines 1-2 of Claim 14). It is clear that all the elements of Claim 14 of the application are to be found in Claim 14 of the patent. Since Claim 14 is anticipated by Claim 14 of the patent, it is not patentably distinct from Claim 14 of the application.

Claim 15 recites, “at least one of the electrodes is longitudinally movable such that it can be extended and retracted with respect tot the other electrodes” (See lines 1-

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3 of Claim 15). It is clear that all the elements of Claim 15 of the application are to be found in Claim 15 of the patent. Since Claim 15 is anticipated by Claim 15 of the patent, it is not patentably distinct from Claim 15 of the application.

Claim 16 recites, "the longitudinally-movable electrode is positioned centrally between the other electrodes" (See lines 1-3 of Claim 16). It is clear that all the elements of Claim 16 of the application are to be found in Claim 16 of the patent. Since Claim 16 is anticipated by Claim 16 of the patent, it is not patentably distinct from Claim 16 of the application.

Allowable Subject Matter

15. Claims 12,13,15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

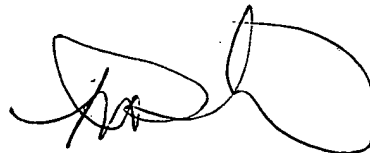
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth C. Williams whose telephone number is (571) 272-8161. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Linda C. M. Dvorak', with a large, stylized loop at the end.

LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700

KCW